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PATENT
P56354
1-24-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

CHANG-WOONG YOO

Serial No.: 09/836,333

Examiner: ROCHE, TRENTON J

Filed: 18 April 2001

Art Unit: 2124

For: COMPUTER SYSTEM AND METHOD FOR STORING PRODUCT KEYS
THEREOF

PETITION UNDER 37 C.F.R. §1.104 and §1.181

Mail Stop : Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

JUN 22 2004

Technology Center 2100

Sir:

Applicant respectfully petitions from the incompleteness of the first Office action (Paper No. 4) dated on the 3rd of June 2004, request clarification and completion of the Office action in conformity with 37 CFR §1.104(a) and (b), request proper and complete consideration of applicant's Information Disclosure Statement filed simultaneously with the application on the 18th of April 2001, and request re-starting the period for response set forth in Paper No. 4, and as reasons therefore states that:

Folio: P56354
Date: 6/16/04
I.D.: REB/ny

STATEMENT OF FACTS

1. On the 18th of April 2001, simultaneously with the filing of applicant's above-referenced U.S. Patent application, applicant filed an Information Disclosure Statement, listed, discussed and provided complete copies of (1) Korean Patent Publication KR1999-48136 and (2) Japanese Patent Publication JP9-305381, filed simultaneously with the above-captioned original U.S. Patent application
2. On or about the 3rd of June 2004 the Examiner issued Paper No. 4 and stated that:

"Information Disclosure Statement (IDS) submitted on 18 April 2001 has been considered, however, foreign patent documents KR1999-48136 and JP9-305381 have not been considered as no translation of any part of the document has been provided."

REMARKS

Under 37 CFR §1.98, the translation of a non-English language document is not mandatory, and §1.98(a)(3)(ii) states that:

“A copy of the translation if a written English language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in §1.56(c).”

No English language translation of either of the two foreign language patent references, or any portion thereof, was available to applicant as of the filing date of the Information Disclosure Statement on the 18th of April 2001; consequently, applicant was unable to provide English language translations of any portions of those references, but did provide complete copy of both references. The Scientific Library of the U.S. TPO has faithfully either provided translations or obtain translations of foreign patent documents for well over thirty years, at the convenience of the Examiners. The translation service of the Scientific Library is accurate and quick. There is no explanation why this service was unavailable to the Examiner in this application.

Second, under 37 CFR §1.98(a)(3)(ii), there is no mandatory requirement that an English language translation be provided or that authorizes the Examiner to refuse to consider a non-English language document if applicant has not either provided a copy of an English language translation or if an English language translation is not within the possession, custody, or control of, or is not readily available to any individual designated in §1.56(c).

Third, 37 CFR §1.104(a)(1) expressly states that:

“The examination shall be complete with respect both to compliance of the application ... with the applicable statutes and

rules ... as well as with respect to matters of form, unless otherwise indicated.”

Here, no effort was made by the Examiner to consider either of the two foreign language patent references. Consequently, there is no effort to comply with §1.104(a)(1).

Fourth, under 37 CFR §1.104(b),

“The Examiner’s action will be complete as to all matters”


Given the refusal of the Examiner to make any effort to consider either of the two foreign patent references, despite applicant’s compliance with 37 CFR §1.56, §1.97 and §1.98, Paper No. 4 lacks the completeness required by 37 CFR §1.104(b).

RELIEF REQUESTED

The Commissioner is therefore, respectfully requested to:

- A. Return the application to the Examiner for completion of a first action on the merits that complies with the requirements for completeness set forth in 37 CFR §1.104(a)(b);
- B. Return the application to the Examiner for consideration of all patent references cited in applicant's Information Disclosure Statement;
- C. Explain to the Examiner the availability of the prompt and accurate translation services that have been kindly provided for by the Scientific Library to the examining Corp for well over three decades;
- D. Re-start the period for response to Paper No. 4 to conform with the Examiner's completion of the first examination; and
- E. Grant such other and further relief as justice may require.

Respectfully submitted,


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